

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

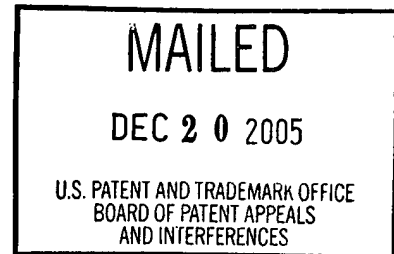
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. MULDOON

Appeal No. 2005-1507
Application No. 09/612,156

ON BRIEF



Before KIMLIN, GARRIS, and FRANKLIN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-9, 11-26, 28-41, 43-57 and 59-66.

The subject matter on appeal relates to a process for distributing product entitlements in a retail store to shoppers who are members of the retail store's frequent shopper program. The process comprises the steps of obtaining from the retail store frequent shopper program member data, selecting available product entitlements based on a comparison of the product purchase

history of each member account number, providing a dispenser within the retail store which is activated by a frequent shopper program member by entering information identifying the member's frequent shopper member account number, and printing (via the dispenser) the previously selected product entitlements for the frequent shopper program member. Further details regarding this subject matter are set forth in representative independent claim 1 which reads as follows:

1. A process for distributing product entitlements in a retail store to shoppers who are members of the retail stores' [sic] frequent shopper program, comprising the steps of:

obtaining from the retail store frequent shopper program member data, including individual frequent shopper program member account numbers and product purchase histories of the individual shopper program member account numbers comprising past product purchases, with or without a coupon, using the frequent shopper member account number at the retail store over a predetermined time period;

comparing the product purchase history of each member account number to a database of available product entitlements;

selecting available product entitlements to be associated with each member account number based on the comparison;

providing a dispenser within the retail store which is accessible to and activated by a frequent shopper program member by entering information identifying the member's frequent shopper member account number; and

communicating the previously selected entitlements for the frequent shopper member account number which activated the dispenser to the dispenser and printing the previously selected product entitlements for the frequent shopper program member.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Day et al. (Day)	5,857,175	Jan. 5, 1999
Barnett et al. (Barnett)	6,321,208	Nov. 20, 2001

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnett in view of Day.¹

Rather than reiterate the respective positions advocated by the appellant and by the examiner concerning this rejection, we refer to the brief and to the answer respectively for a complete exposition thereof.

OPINION

We agree with the findings of fact, conclusions of law and rebuttals to argument expressed by the examiner in his answer. Accordingly, we adopt these findings, conclusions and rebuttals as our own. We add the following comments for emphasis and completeness.

The appellant disagrees with the examiner's finding that Day's method for distributing product entitlements involves use of a retail store's frequent shopper program. It is argued by the appellant in his brief and stated by Dr. Banks in the Section 1.132 declaration of record, upon which the appellant relies, that Day creates a system completely independent of the retailer's frequent shopper program system. Notwithstanding a thorough study of the appellant's brief and the Banks declaration concerning this matter, we do not consider this finding by the examiner to be erroneous.²

Importantly, at no point is Day's system characterized as separate from or additional to a retail store's frequent shopper program system. Instead, the Day patent simply discloses a

¹ As indicated on pages 4-6 of the brief, certain of the appealed claims have been separately grouped and argued. Accordingly, in assessing the merits of the above-noted rejection, we have individually considered each of these separated grouped and argued claims. See 37 CFR § 1.192(c)(7)(2004).

² Interestingly, the appellant acknowledges in his specification that frequent shopper programs are known in the prior art. For example, see the paragraph bridging specification pages 3 and 4.

system for use by retail stores which includes a frequent shopper program or plan (e.g., see lines 17-45 in column 3 and lines 21-55 in column 5). Precisely because this system is designed for use by a retail store, it may be properly characterized as a retail store's frequent shopper program of the type required by the appealed claims. It is here appropriate to emphasize that the aforementioned characterization still would be appropriate even if the retail store used an additional frequent shopper program separate from the system of Day. Where both the additional as well as the Day frequent shopper program are used by a retail store, it would be proper to consider each of them as the retail store's frequent shopper program. Regarding this point, it is significant that the appealed claims do not exclude the circumstance wherein the retail store may use plural, independent frequent shopper programs.

For the above-stated reasons and those expressed in the answer, we agree with the examiner's finding that the retail store system of Day includes a retail store's frequent shopper program in accordance with the requirements of the appealed claims. We also agree with the examiner's conclusion that it would have been obvious to provide the entitlements distributing method of Barnett with the retail store's frequent shopper program described by Day to thereby provide the former with the advantages of the latter as more fully detailed in the answer. We reach this obviousness conclusion despite a thorough consideration of the appellant's arguments and evidence (i.e., the Banks declaration) for nonobviousness. This argument and evidence are not convincing of patentability for the reasons set forth in the answer. With regard to the Banks' declaration specifically, this declaration evidence possesses limited probative value. This is because the declarant incorrectly presumes that the retail store's frequent shopper program requirement of the appealed claims distinguishes from the frequent shopper program system of

Day. As a more general deficiency, the declaration inappropriately compares Barnett and Day to the appellant's invention as disclosed in the specification rather than as defined in the appealed claims. Indeed, the declaration contains no reasonably specific discussion or analysis of any particular claim on appeal.

The appellant also argues that it would not have been obvious to provide Barnett's method with a dispenser/printer in accordance with the teachings of Day because "Barnett explicitly describes the perceived disadvantages of using kiosk-type printer stations located at a retail store" (brief, page 11). In this regard, we recognize that Barnett teaches a preference for the advantages of his system wherein entitlements are printed and dispensed via a personal computer rather than via a dispenser/printer located within a retail store. Contrary to the appellant's belief, however, Barnett's teaching of a preference does not constitute a teaching away from the proposed combination under review. See In re Fulton, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Thus, for example, an artisan would have been motivated to provide Barnett's method with a dispenser/printer as taught by Day in order to provide this dispensing/printing service to users who do not possess or do not know how to use a personal computer.

Finally, on pages 14 and 15 of the brief, the appellant argues that the features of dependent claims 2, 3, 9, 11, 12, 13 and 16 are not disclosed by either Barnett or Day. This is not correct. Each of these features is disclosed in at least the Barnett reference (column 5 of Day also discloses the claim 9 feature) which the examiner has thoroughly and specifically explained on pages 18 and 19 of the answer.

For the reasons set forth above and in the answer, it is our ultimate determination that the argument and evidence of record, on balance, weigh most heavily in favor of an obviousness conclusion for the examiner's proposed combinations of the Barnett and Day teachings. We hereby sustain, therefore, the examiner's Section 103 rejection of all appealed claims as being unpatentable over Barnett in view of Day. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

Edward Kinkle.

Edward C. Kimlin
Administrative Patent Judge

Bradley R. Harris
Bradley R. Harris

Bradley R. Garris
Administrative Patent Judge

Beverly A. Franklin

Beverly A. Franklin
Administrative Patent Judge

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